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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,985	08/04/2003	Inna Karpov	SC06082-01	5616
24265	7590	03/27/2006	EXAMINER	
SCHERING-PLOUGH CORPORATION PATENT DEPARTMENT (K-6-1, 1990) 2000 GALLOPING HILL ROAD KENILWORTH, NJ 07033-0530			GOLLAMUDI, SHARMILA S	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,985	<b>Applicant(s)</b> KARPOV, INNA	
	<b>Examiner</b> Sharmila S. Gollamudi	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 1-22 are pending in this application.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Singleton (PGPUB 2004/126337).**

Singleton discloses a composition containing (i) a lipophilic sunscreen, (ii) a copolymer of sodium acryloyldimethyltaurate and one or more acryls, and (iii) an oil-absorbant. See abstract.

Singleton discloses the composition contains 0.1 to about 50 percent and at least 10% of one or more lipophilic sunscreens. See [0016]. Examples of suitable sunscreens include octocrylene, homosalate, octinoxate, octisalate, avobenzene, oxybenzone, benzophenone-1, benzophenone-2, benzophenone-8, benzophenone-12, ethyl dihydroxypropyl PABA, glyceryl PABA, menthyl antranilate, ethylhexyl dimethyl PABA, methylbenzylidene camphor, isopropyl dibenzoyl methane, and octocrylene. See [0015]. Examples of oil-absorbing agents include, silica (e.g., spherical silicas, porous silicas, and fumed silica powders). See [0021].

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Specifically example 1 discloses a sunscreen composition having a SPF of 45. The emulsion comprises water, 0.1-15% homosalate (preferably 15%), 0.1-5% ethylhexyl salicylate (preferably 5%), 0.1-7.5 ethylhexylmethoxycinnamate (preferably 7.5%), 0.1-6% benzephone-3 (preferably 6%), 0.1-3% avobenzene (preferably 2%), 0.1-20% silica (spheron L-500) (preferably 3.5%), 0.1-10% dimethicone (oil component), 0.1-10% dimethicone & trimethylsiloxysilicate (oil component), and 0.1-10 cetyl dimethicone (oil component), 0.1-10% glyceryl stearate (oil component), among other components. Note that Spheron L-500 is a porous silica, 3-15 microns powder.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0679382.**

EP '382 discloses cosmetic composition comprising porous silica spheres with a diameter of 1-50 microns and preferably 2-20 microns. See page 55-60 and page 3, lines 5-10.

Specifically, example 15 discloses a cream comprising 17% liquid paraffin (water-insoluble organic ingredient), 3% cetanol (water-insoluble organic ingredient), 3% glyceryl monostearate (water-insoluble organic ingredient), 1% propylene glycol monostearate (water-insoluble organic ingredient), 10% silica treated powder, and water among other components. Note that the recitation "at least about 25%" is met. Example 12 discloses 3% stearic acid (water-insoluble organic ingredient), 9% isopropyl myristate (water-insoluble organic ingredient), 1.5% liquid paraffin (water-insoluble organic ingredient), 1% cetanol (water-insoluble organic ingredient), 2% coloring pigments, 6% silica treated powder, and water among other components.

**Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Vatter et al (6,696,049).**

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Vatter discloses a cosmetic compositions comprising: (i) from about 0.1% to about 15% of crosslinked organosiloxane elastomer having an average particle size less than 20 microns; (ii) from about 10 to about 80% of a solvent for the crosslinked siloxane elastomer; (iii) optionally, from 0 to about 50% of skin conditioning agent; and (iv) optionally, from above about 0 to about 95% of water. The cosmetic compositions preferably comprise water at from about 1% to about 95%, preferably from about 5% to about 90%, most preferably from about 10% to about 85%. See column 2, lines 5-30.

Vatter discloses the use of shine control agent to improve and/or regulate the condition of the shiny appearance of skin, which are typically porous in nature. Vatter discloses these agents, when applied to the skin provide a reservoir to absorb excess moisture into the pores, hence reducing the visible quantity of moisture on the skin. Vatter discloses it is preferable to combine the use of effective porous, absorbent materials with non-absorbing spherical materials (the organosiloxane). Vatter discloses silicas, particularly silica ellipsoids and silica microspheres in the amount from about 1% to about 40%; more preferably from about 1% to about 25%, and most preferably from about 2% to about 10%, by weight of the composition. Vatter discloses silica ellipsoids are available from DuPont as ZELEC Sil and Kobo as Silica Shells. Silica microspheres are available from Kobo as MSS-500, MSS500/3, MSS-500H, MSS500/3N, MSS-500N and MSS 500/3N; Presperse as Spheron L1500, Spheron P1500. Note these spheres have the instantly claimed particle size. See column 11, lines 4-54 and example V and IX-X.

Vatter also discloses the use of film forming agents to aid film substantivity and adhesion to the skin, which improve the long wear and non-transfer performance. Water-soluble, water insoluble, and water dispersible film forming agents are taught in the amount of about 0% to

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about 20%, more preferably, from about 0.1% to about 10%, and most preferably, from about 0.1% to about 5%. Organic silicone resins, polymer resins, polyurethane resins, and styrene-based materials are taught, all of which are water-insoluble organic materials. See column 12, line 25 to column 13, lines 5.

Vatter discloses the compositions preferably comprise an organic sunscreen, which have UVA absorbing properties, UVB absorbing properties, or a mixture thereof. The exact amount of the sunscreen active depends on the desired Sun Protection Factor, i. e., the "SPF" of the composition as well as the desired level of UVA protection. The compositions of the present invention preferably comprise an SPF of at least 10, preferably at least 15. UVA sunscreens are taught in the amount of 4-14% and a preferred UVA sunscreen is avobenzone. UVB sunscreens are taught in the amount of 0.1-16% and the preferred UVB sunscreen is octocrylene. See column 20, line 34 and line 66.

Skin conditioning agents including emollients are selected from hydrocarbons, fatty acids, fatty alcohols and esters in the amount of 1-10% preferably.

Examples IX-X disclose a cream foundation for controlling shine comprising 5% silica (instant particles), 10% ethylene/acrylic acid copolymer microspheres (water-insoluble organic material), 31% cyclomethicone (oil component), 17.50% organopolysiloxane elastomer, 2% ally methacrylate copolymer (water insoluble organic component), and water, among other components. Note that the acrylate based spherical particles are disclosed in an amount of 8-30%. See column 12, lines 20-25.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vatter et al (6,696,049).**

Vatter discloses a cosmetic compositions comprising: (i) from about 0.1% to about 15% of crosslinked organosiloxane elastomer having an average particle size less than 20 microns; (ii) from about 10 to about 80% of a solvent for the crosslinked siloxane elastomer; (iii) optionally, from 0 to about 50% of skin conditioning agent; and (iv) optionally, from above about 0 to about 95% of water. The cosmetic compositions preferably comprise water at from about 1% to about 95%, preferably from about 5% to about 90%, most preferably from about 10% to about 85%. See column 2, lines 5-30.

Vatter discloses the use of shine control agent to improve and/or regulate the condition of the shiny appearance of skin, which are typically porous in nature. Vatter discloses these agents, when applied to the skin provide a reservoir to absorb excess moisture into the pores, hence reducing the visible quantity of moisture on the skin. Vatter discloses it is preferable to combine the use of effective porous, absorbent materials with non-absorbing spherical materials (the organosiloxane). Vatter discloses silicas, particularly silica ellipsoids and silica microspheres in the amount from about 1% to about 40%; more preferably from about 1% to about 25%, and most preferably from about 2% to about 10%, by weight of the composition. Vatter discloses

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silica ellipsoids are available from DuPont as ZELEC Sil and Kobo as Silica Shells. Silica microspheres are available from Kobo as MSS-500, MSS500/3, MSS-500H, MSS500/3N, MSS-500N and MSS 500/3N; Presperse as Spheron L1500, Spheron P1500. Note these spheres have the instantly claimed particle size. See column 11, lines 4-54 and example V and IX-X.

Vatter also discloses the use of film forming agents to aid film substantivity and adhesion to the skin, which improve the long wear and non-transfer performance. Water-soluble, water insoluble, and water dispersible film forming agents are taught in the amount of about 0% to about 20%, more preferably, from about 0.1% to about 10%, and most preferably, from about 0.1% to about 5%. Organic silicone resins, polymer resins, polyurethane resins, and styrene-based materials are taught, all of which are water-insoluble organic materials. See column 12, line 25 to column 13, lines 5.

Vatter discloses the compositions preferably comprise an organic sunscreen, which have UVA absorbing properties, UVB absorbing properties, or a mixture thereof. The exact amount of the sunscreen active depends on the desired Sun Protection Factor, i. e., the "SPF" of the composition as well as the desired level of UVA protection. The compositions of the present invention preferably comprise an SPF of at least 10, preferably at least 15. UVA sunscreens are taught in the amount of 4-14% and a preferred UVA sunscreen is avobenzone. UVB sunscreens are taught in the amount of 0.1-16% and the preferred UVB sunscreen is octocrylene. See column 20, line 34 and line 66.

Skin conditioning agents including emollients are selected from hydrocarbons, fatty acids, fatty alcohols and esters in the amount of 1-10% preferably.



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Vatter does not specifically teach a combination of the instant sunscreens and instant porous silica particles.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to look to the guidance provided by Vatter et al and utilize the instant combination of silica particles and organic sunscreens, particularly the instant sunscreens. For instance, Vatter teaches a cream for oil control comprising the instant silica particles and thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to further add organic sunscreens to this composition if one desired to render a shine control cream foundation that provides UV protection. Furthermore, one would have been motivated to add the desired concentration of the sunscreen to provide the desired SPF as taught by Vatter on column 19, lines 42-60. Thus, a skilled artisan would have been motivated to manipulate the concentration of the sunscreen to provide the desired SPF wherein an increased concentration of the UVA and UVB sunscreen would provide a higher SPF, which is known in the art.

### ***Conclusion***

All the claims rejected at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is 571-272-0614. The examiner can normally be reached on M-F (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharmila S. Gollamudi  
Examiner  
Art Unit 1616

